REMARKS

Forty-two claims were originally filed in the present Application, and claims 43-54 were subsequently added by amendment. Claims 1-19, 21-39, and 41-42 have been cancelled, and claims 20, 40, and 43-54 currently stand rejected. Claims 43 and 48 are amended herein. In addition, a new claim 55 is added herein. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

Finality Of Present Office Action

In paragraph 1 of the present Office Action, the Examiner also states that "Applicant's arguments with respect to claims 20, 40, 43-54 have been considered but are moot in view of the new ground(s) of rejection." In light of the foregoing new grounds of rejection, Applicants submit that the finality of the present Office Action is not appropriate because Applicant has not had an opportunity to respond to the new grounds of rejection on their merits. Applicant therefore respectfully requests the Examiner to treat the present final Office Action as a non-final Office Action, so that Applicant may have an opportunity to adequately discuss and respond to the new grounds of rejection.

Rejection under 35 U.S.C. §112, Second Paragraph

In paragraph 3 of the Office Action, the Examiner indicates that claim 48 is rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response, Applicant amends claim 48 to provide antecedent basis for the limitation "said video tag". In view of the foregoing remarks and/or amendments, Applicant believes that the Examiner's rejection is addressed, and respectfully requests that the rejection under 35 U.S.C. §112, second paragraph be withdrawn so that claim 48 may issue in a timely manner.

35 U.S.C. § 103

In paragraph 5 of the Office Action, the Examiner rejects claims 20, 40, 43-47, 49, and 53-54 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,940,073 to Klosterman et al. (hereafter Klosterman). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

> "First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Throughout the present Office Action, the Examiner repeated states that the cited references fail to "explicitly disclose" various claimed limitations. However, the Examiner then cursorily concludes that those same claimed limitations are "obvious to one of ordinary skill in the art", without providing any specific references as support for the rejections of the foregoing limitations. More specifically, the foregoing type of Examiner language is used to reject claims 20, 40, 43, 45, 46, 47, 51, and 53.

Furthermore, the Examiner also states that certain claimed limitations in claims 20, 40, 43, 44, and 48 are "inherent" without providing any specific references as support for those rejections. As discussed above, for a proper rejection under 35 U.S.C. § 103(a), the prior art reference (or references when combined) must teach or suggest all the claim limitations. Applicant therefore submits that the Examiner has failed to establish a prima facie case of obviousness.

It appears that the Examiner may be utilizing Official Notice without expressly stating so. Applicant respectfully traverses the Examiner's rejections on these grounds, and submits that each of the rejected claims contains patentable subject matter that is not obvious to one skilled in the corresponding art. Applicant therefore respectfully requests the Examiner to cite specific references in support of these rejections, and failing to do so, to reconsider and withdraw the rejections of claims 20, 40, 43-48, 51, and 53, so that the present Application may issue in a timely manner.

Furthermore, the Court of Appeals for the Federal Circuit has held that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination." In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Applicant submits that the cited references, in combination with the Official Notice, do not suggest a combination that would result in Applicant's invention, and therefore the obviousness rejections under 35 U.S.C §103 are improper. Applicant therefore respectfully requests the Examiner to cite references in support of the Official Notice, and to also indicate where an explicit teaching to combine the cited reference may be found. Alternately, the Applicant requests that the Examiner reconsider and withdraw the rejections of claims 20, 40, 43-48, 51, and 53 under 35 U.S.C §103.

Regarding the Examiner's rejection of independent claim 43, Applicant responds to the Examiner's §103 rejection as if applied to independent claim 43 which is amended herein to recite *"said video data received from a video programming source and said Internet page data are simultaneously shown on said display device,"* which are limitations that are not taught or suggested either by the cited reference, or by the Examiner's citations thereto.

Klosterman teaches a system that "provides a program schedule guide with information regions for displaying additional information." The foregoing information regions may be "used for displaying advertising or promotional messages . . . ." (column 1, lines 52-53). However, unlike Applicant's claimed invention, Klosterman nowhere teaches downloading "Internet page data". In addition, Klosterman fails to disclose inserting "video data received from a video

programming source," as claimed by Applicant. Furthermore, Klosterman teaches scrolling the inserted window (information regions), which is the opposite of Applicant's scrolling of the background Internet page data.

With regard to claim 44, the Examiner states "[i]nherently, the format manager positions a video tag to vertically location the video window . . . ." Applicant respectfully submits that the cited reference fails to teach or disclose positioning "a video tag to vertically locate said video window on said display device in relation to a current reference position on said display device," as claimed by Applicant. With regard to claim 45, the Applicant respectfully submits that neither of the cited references teach or disclose copying "Internet page data" to create "duplicate Internet page data," as claimed by Applicant in claim 45. With regard to claim 46, the Applicant submits that Klosterman fails to teach scrolling page data of the background document, but rather teaches scrolling of information within the "information regions" (see column 2, lines 1-2).

Further regarding the Examiner's rejection of dependent claims 44-47,49, and 53-54, for at least the reasons that these claims are directly or indirectly dependent from an independent claim whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested. Applicant therefore respectfully requests reconsideration and allowance of dependent claims 44-47,49, and 53-54, so that these claims may issue in a timely manner.

For at least the foregoing reasons, the Applicant submits that claims are not unpatentable under 35 U.S.C. § 103 over Klosterman, and that the rejections

under 35 U.S.C. § 103 are thus improper. The Applicant therefore respectfully requests reconsideration and withdrawal of the rejections of claims 20, 40, 43-47, 49, and 53-54 under 35 U.S.C. § 103.

In paragraph 6 of the Office Action, the Examiner rejects claim 48 under 35 U.S.C. § 103 as being unpatentable over Klosterman in view of U.S. Patent No. 5,940,073 to Judson et al. (hereafter Judson). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claim 48, for at least the reasons that this claim is dependent from an independent claim whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested. Applicant therefore respectfully requests reconsideration and allowance of dependent claim 48, so that this claim may issue in a timely manner.

Furthermore, in the rejection of claim 48, the Examiner concedes that "Klosterman does not specifically disclose the video tag includes a video

source parameter . . . ." Applicant concurs. The Examiner then points to Judson to purportedly remedy this deficiency. Judson teaches "the display of some useful information to the user during the period of user "download" time . . . ." (column 1, lines 60-63). Applicant respectfully disagrees with this interpretation of Judson.

The Examiner cites Figures 5-8 and column 1, lines 60+ of Judson against Applicant's claimed "video source parameter". Applicant submits that column 1, lines 60+ of Judson completely fail to discuss any sort of "video source parameter" implemented as part of a "video tag", as claimed by Applicant. Furthermore, Applicant respectfully submits that the "PTO seal" disclosed in Figures 5-8 of Judson is not a "video source parameter" because it fails to disclose the specific location/source of corresponding video data.

For at least the foregoing reasons, the Applicant submits that claim 48 is not unpatentable under 35 U.S.C. § 103 over Kosterman in view of Judson, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicant therefore respectfully requests reconsideration and withdrawal of the rejection of claim 48 under 35 U.S.C. § 103.

In paragraph 7 of the Office Action, the Examiner rejects claims 50-52 under 35 U.S.C. § 103 as being unpatentable over Klosterman in view of U.S. Patent No. 5,844,620 to Coleman et al. (hereafter Coleman). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for

a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicant respectfully traverses the Examiner's assertion that modification of the device of Klosterman according to the teachings of Coleman would produce the claimed invention. Applicant submits that Klosterman in combination with Coleman fail to teach a substantial number of the claimed elements of the present invention. Furthermore, Applicant also submits that neither Klosterman nor Coleman contain teachings for combining the cited references to produce the Applicant's claimed invention. The Applicant therefore respectfully submits that the obviousness rejections under 35 U.S.C §103 are improper.

Regarding the Examiner's rejection of dependent claims 50-52, for at least the reasons that these claims are directly or indirectly dependent from an independent claim whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the independent claim, are also not identically taught or suggested. Applicant therefore respectfully requests reconsideration and allowance of dependent claims 50-52, so that these claims may issue in a timely manner.

Furthermore, in the rejection of claims 50-52, the Examiner concedes that "Klosterman does not specifically disclose automatically reformats text data and graphics data from the page data . . . ." Applicant concurs. The Examiner then

points to Coleman to purportedly remedy this deficiency. Applicant respectfully disagrees with this interpretation of Coleman.

Coleman teaches that "an existing [television] program can be reformatted when the program guide is displayed in a partial screen mode." (column 3, lines 19-21). Coleman therefore teaches reformatting video programming. Applicant respectfully submits that the reformatting process of Coleman is therefore the opposite of Applicant's reformatting of Internet page data while maintaining the inserted video data without any reformatting procedure.

For at least the foregoing reasons, the Applicant submits that claims are not unpatentable under 35 U.S.C. § 103 over Kosterman in view of Coleman, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicant therefore respectfully requests reconsideration and withdrawal of the rejections of claims 50-52 under 35 U.S.C. § 103.

New Claim 55

The Applicant herein submits additional claim 55 for consideration by the Examiner in the present Application. The new claim 55 recites specific details for implementation and utilization of Applicant's invention, as disclosed and discussed in the Specification. Applicant submits that newly-added claim 55 contain a number of limitations that are not taught or suggested in the cited references. Applicant therefore respectfully requests the Examiner to consider and allow new claim 55, so that this claim may issue in a timely manner.

Summary

Applicant submits that the foregoing amendments and remarks overcome the Examiner's rejections of claims 20, 40, and 43-54. Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicant therefore submits that the claimed invention is patentable over the cited art, and respectfully requests the Examiner to allow claims 20, 40, and 43-55 so that the present Application may issue in a timely manner. If there are any questions concerning this amendment, the Examiner is invited to contact the Applicant's undersigned representative at the number provided below.

Respectfully submitted,

Date: 11/20/04

By: _____

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